

***United States Court of Appeals
for the Second Circuit***



APPELLEE'S BRIEF

ORIGINAL
74-1559

To be argued by
Stuart A. White

IN THE
United States Court of Appeals
FOR THE SECOND CIRCUIT

VANITY FAIR MILLS, INC.,
Plaintiff-Appellant,

vs.

OLGA COMPANY (INC.),
Defendant-Appellee.

Appeal from the United States District Court for the
Southern District of New York to Review Decision
in a Declaratory Judgment Patent Action

DEFENDANT-APPELLEE'S BRIEF

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TABLE OF CONTENTS

	<u>Page</u>
Table of Authorities	(i)
POINT I	
STATEMENT OF THE FACTS.	2
A. The Trial Court's Findings as to the Olga Invention of the Patents in Suit.	2
B. The Trial Court's Findings as to the Differences between the Prior Art and the Patents in Suit.	7
1. The Peck garment.	8
2. The Rosenthal garment.. . . .	9
3. The prior art Olga garment. .	10
C. The Trial Court's Resolution of the Level of Ordinary Skill of the Art.	10
POINT II	
NOTHING IN THE FILE WRAPPERS OF THE PATENTS IN SUIT REFLECTS ADVERSELY ON THE VALIDITY OF THOSE PATENTS	11
POINT III	
THE GARMENT PATENT CASES RELIED ON BY VANITY FAIR ALL INVOLVED VERY DIFFERENT FACTS FROM THOSE HERE PRESENT . .	13
POINT IV	
THE 301 PATENT IN SUIT IS NOT PRIOR ART AS TO THE 300 PATENT IN SUIT	14
CONCLUSION	16



TABLE OF AUTHORITIES

<u>Cases Cited</u>	<u>Page</u>
J. R. Clark Co. v. Jones & Laughlin Steel Corp., 288 F.2d 279 (7th Cir. 1961), cert. den. 368 U.S. 828 (1961).....	15, 16
Formal Fashions, Inc. v. Braiman Bows, Inc., 362 F.2d 536 (2 Cir. 1966).....	14
H. W. Gossard Co. v. J. C. Penny, 304 F. 2d 515, 516 (2 Cir. 1962).....	14
International Latex Corp. v. Warner Bros. Co., 276 F. 2d 557, 562 (2 Cir. 1960).....	13
Modella Manufacturing Co. v. Famous Bathrobe Co., 151 F.Supp. 542, 543 (S.D.N.Y. 1956).....	13
Pursche v. Atlas Scraper & Engineering Co., 300 F.2d 467 (9th Cir. 1961), cert. den. 371 U.S. 911 (1962).....	16
Rich Products Corp. v. Mitchell Foods, Inc., 357 F.2d 176 (2 Cir. 1966), cert. denied, 385 U.S. 281 (1966).....	12
W. A. Sheaffer Pen Co. v. Eagle Pencil Co., 55 F.2d 420 (S.D.N.Y. 1931).....	16
Therorz Co. v. United States Ind. Chemical Co. Inc., 14 F.2d 629, 640 (D.C. Md. 1926), aff'd 25 F. 2d 387 (4th Cir. 1928), cert. den. 278 U.S. 608.....	15
Underwood v. Gerber, 149 U.S. 224 (1893).....	15
Warner Bros. Co. v. American Lady Corset Co., 136 F.2d 93, 95 (2 Cir. 1943).....	13
Warner Bros. Co. v. Treo Co. , 33 F. Supp. 741 (E.D.N.Y. 1940).....	13

Statutes Cited

Page

Title 35 U.S.C.A. §120.....	15
-----------------------------	----

Articles

Federico, Commentary on the New Patent Act, Title 35 U.S.C.A., Vol. 1, p. 33.....	15
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United States Court of Appeals
For The Second Circuit
No. 74-1559

VANITY FAIR MILLS, INC.,
Plaintiff-Appellant,
v.
OLGA COMPANY (INC.),
Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK;

TO REVIEW DECISION IN A DECLARATORY
JUDGMENT PATENT ACTION

DEFENDANT-APPELLEE'S BRIEF

It is clear from Vanity-Fair's brief that the
sole ground upon which it seeks reversal is that the patents
in suit are invalid for alleged obviousness over the prior



art Peck (App. E73), Rosentahl (App. E67) and Olga (App. E83) patents and the garments therein described. Non-infringement is asserted solely on the basis of invalidity--not that the Vanity-Fair garment fails to respond to the patent claims in suit. PBr 35.*

POINT I

STATEMENT OF THE FACTS

Surely it must be a unusual--if not unique--experience for this court to receive Vanity-Fair's brief, which makes no reference whatever to any of the lower courts' findings of fact and conclusions of law, and argues this appeal as though it were a single pre-trial motion for summary judgment based upon the file wrappers of the patents in suit and disclosures of published prior art. A trial court's findings can not thus be easily ignored, however, and we therefore submit the following statement of the relevant facts as found by the court below from the evidence adduced at the hearing.

A. The Trial Court's Findings as to the Olga Invention of the Patents in Suit.

There are three different types of body control

* In this brief we use P Br to designate Plaintiff-Appellant's Brief, and we refer to Plaintiff-Appellant as Vanity-Fair and we refer to Defendant-Appellee as Olga.

undergarments worn by women--girdles, panty girdles and briefs. These are described by the court below at App. 50a-52a. A girdle (according to the nomenclature of this business) is tubular in shape, designed to encircle the body in the region of the abdomen, hips and buttocks, and is made of elastic material. It has no legs or crotch segment, and therefore has to be attached by garters to stockings to prevent it from riding up on the body. Examples are shown in Exhibits 8 and 9.

A panty girdle, instead of being completely unenclosed at its lower edge, has short legs joined by a crotch. The leg portions surround and elastically grip the upper portions of the thighs of the wearer in addition to the abdomen, hips and buttocks. A panty girdle needs no garters to prevent it from riding up. Examples are shown in Exhibits 6, 8, 10, 11 and 12.

The third category--briefs--have a crotch which prevents the garment from riding up, but have no legs. The body control afforded by a brief is similar to that afforded by an ordinary girdle, i.e., it does not provide thigh control. Having a crotch, however, it has individually defined leg openings, which are not present in a girdle. It is this category of garment to which the Olga patents in suit relate. App. 50a-51a.

The presence of a crotch and the absence of legs

in a brief creates a special problem not found in girdles and panty girdles, namely, how to build into the garment sufficient elastic strength for body control without causing the leg openings defined by the crotch segment of the garment to be too constrictive for comfort.

The Court below found that "it proved to be difficult to build into a light garment such as a panty brief any adequate stomach control. Also, there was the aggravation of the leg and crotch discomfort. These were basic problems...." App.63a. This was the problem--peculiar to briefs-- which Mrs. Erteszek sought to solve. It was not a problem of ornamentation; it had to do with the functional characteristics of the garment.

The District Court described the purpose of Mrs. Erteszek's invention as being "to alleviate the crotch and leg discomfort which were problems in prior designs of briefs." App.53a.

As Mrs. Erteszek explained, speaking of her solution to these problems, "it is a great art to be able to achieve the cupping of the garment under the buttocks so that it won't slip up and be uncomfortable, and at the same time the looseness in the front so that it won't cut it. Because it is very easy to take something tight and put it around it and make sure that it stays on the body, but then it hurts." App.352a.

The District Court's description of Mrs. Erteszek's novel solution to the leg-binding problem is both correct and succinct:

"In 1962 Mrs. Erteszek worked out a design of a brief which represented a substantial change in construction from prior models of this type of garment.

. . .

"The Erteszek 301 brief is made up basically of two constituent members. The first member is a torso-encircling elastic body which serves the purposes of a girdle. The second member consists of a separate piece of fabric which is cut and sewn in such a way as to constitute a panel which overlays the girdle member in the front, and then extends down under the crotch and is attached to the girdle member at the back.

. . .

"The unique feature of the 301 design is that the leg openings are able to adjust naturally as the position of the wearer changes. This results from the fact that...the girdle member and the panel-crotch member can move independently of each other." App.52a-53a.

At the same time the Erteszek invention provides an increased degree of body control -- a property antithetical to that of leg comfort in conventional brief designs.

Mrs. Ertezek's independently acting panel-crotch member gave rise to a new problem, however. The front lower

edge of the torso-encircling body portion of the garment (now freed from attachment to the crotch) tended to ride up beneath the overlying panel-crotch member. Mrs. Erteszek's solution to this new problem was to insert a loose freely flexible but non-elastic, inner "crotch piece" connecting the lower front edge of the body portion to the outer panel-crotch member near its bottommost point. This is the improvement claimed in the 300 patent. App.53a-54a.

While at first blush it might seem that the addition of such an inner crotch piece to the Erteszek brief creates completely encircling (and therefore uncomfortable) leg openings--the very thing sought to be avoided by the independently acting panel-crotch member--the surprising fact is that the outer member acts to relieve the constricting force which the inner crotch piece would impose on the groin in the absence of the outer, independently acting panel-crotch member. App.346a-353a. The trial court described the improvement of the 300 patent in the following terms:

"The intent [of the improvement represented by the 300 patent] is to have the tricot [inner crotch] piece be loose enough to permit the adjustment of the leg openings as in the 301 garment, while at the same time preventing the girdle member from riding up." App.54a.

The trial court found that "both the 301 and the 300 designs were in fact part of the same inventive process." App.65a.

Defendant did not commercialize the new brief as

initially designed, but the brief in its improved form, i.e., with the inner crotch piece, met with immediate commercial success following its introduction in 1963. App. 57a.

In Vanity Fair's brief, at pp. 33-4, its's counsel refers to a 1966 letter from Vanity Fair requesting his opinion on validity of the patents in suit and quotes the advice which he gave in response. Actually, in its request for that advice Vanity Fair admitted that the "feature of construction" of Olga's patented garment which it liked was "the absence of binding around the legs which is largely the result of the way in which the 'floating' crotch piece is laid in." App. E164.

B. The Trial Court's Findings as to the Differences between the Prior Art and the Patents in Suit.

In its present appeal Vanity Fair relies principally upon two prior art patents (and the garments thereof), these being the Gossard company's Peck design patent 174,054, App. E73, and the Maidenform company's Rosenthal patent 2,763,008, App. E67. Both parties' experts testified that it is necessary to observe the behavior of briefs as worn by a live model bending, sitting, crossing her legs, etc., in order to appreciate the significances of their structural differences, App. 166a, 266a et. seq., and at the trial the court observed and compared the prior art and patented briefs

as so worn. This court should not, therefore, overturn the lower court's findings as to these differences merely on the basis of patent drawings, verbal descriptions and unworn sample garments.

1. The Peck garment.

It is not clear just what reliance Vanity Fair places on the Peck patent and garment in this appeal. The only reference which it makes to that garment appears in the context of a discussion of a decision in which this court held the Peck design patent invalid. P Br. 5-6. In the court below Vanity Fair did place some reliance upon the Peck patent and garment, App. 61a, and the lower court found as follows:

"In the Gossard brief [which is shown in Figure 1 of the lower court's opinion] the leg was cut quite high, and around the leg opening there was sewn a rather wide strip of elastic of a much softer quality--having less 'kick'--than the elastic material in the body of the garment." App. 51a-52a.

"Despite the fact that Gossard termed its garment 'radically different' it was basically the same in design as the earlier briefs, except that its leg openings were made of a softer fabric." App. 52a.

"[N]one of these briefs [including Gossard's Peck garment] included or anticipated the panel and leg opening arrangements of the Olga patents." App. 61a.

An actual Gossard brief is in evidence as Exhibit 20. Its "panel" is sewn to the underneath portion of the garment

throughout its perimeter, and is made of completely non-stretchable, inelastic material. App.171a et. seq.

2. The Rosenthal garment.

At the trial, as in its present appeal, Vanity Fair placed principal reliance upon the Rosenthal patent and garment:

"Vanity Fair asserts (and the Patent Examiner at first held) that the Olga patents were merely obvious rearrangements of elements contained in the Rosenthal patent. Vanity Fair contends that the Rosenthal and Olga designs are basically the same, except for the fact that in Rosenthal there is a panel running downward inside the girdle member, whereas in the Olga patents the downward panel runs outside the girdle member." App. 61a.

Squarely confronting this contention -- which is precisely the same as that made by Vanity Fair here -- the court below found it untenable:

"The differences between the [Olga and Rosenthal] garments are far more fundamental than simply a change in position of a panel." App. 61a-62a.

"[T]he overall result reached in the Olga garment is utterly different from the result in the Rosenthal garment." App.62a.

"The relationships between the downward panel and the girdle member in Rosenthal does not in any way create the type of flexible leg openings involved in the Olga patents, nor are such flexible leg openings even suggested by the Rosenthal design." App.62a.

"The degree and type of stomach control are radically different in the two garments." App.62a.

Contrary to Olga's teachings, moreover, the under-

lying panel of the Rosenthal garment is not elastic, and does not overlay a substantive portion of the front of the body. App.159a. Being inelastic any downward pull on this panel would of necessity, be transmitted directly and without dissipation to the upper edge of the body of the garment, and this would cause the garment as a whole to tend to creep downwardly on the body of the wearer.

3. The prior art Olga garment.

Vanity Fair also relies on Olga Erteszek patent 2,660,173 (App. E83) as an anticipation of the 300 patent's inner flexible crotch piece. The prior Olga patent, however, merely discloses a detachable crotch panel which was provided for sanitary reasons. Clearly that patent has no relevancy whatever to the 300 patent in suit or to the special environment in which the crotch piece of that patent was designed and constructed to function.

C. The Trial Court's Resolution of the Level of Ordinary Skill of the Art.

From uncontradicted evidence, the lower court found:

"In 20 years or more of designing and marketing panty briefs, the foundation garment industry had not produced a design with these benefits [i.e., the Olga design's greater stomach control while affording greater leg and crotch comfort]." App.64a.

"Prior to the design of the accused garment, Vanity Fair's garments partook of the typical stomach and leg problems. Vanity Fair sales executives requested the company's designers to come up with a garment which

afforded a better solution to these problems. What the Vanity Fair designers arrived at was none other than a garment precisely embodying the features of the Olga garment. The accused Vanity Fair garment was that company's most successful brief during the time it was marketed." App.64a.

"[T]he foundation garment industry had worked for many years to solve two problems in the design of panty briefs. It proved to be difficult to build into a light garment such as a panty brief any adequate stomach controls. Also, there was the aggravation of the leg and crotch discomfort. These were basic problems...." App.63a.

"By the time of the trial of this action the Olga brief had been on the market for ten years.... A former executive vice president of Vanity Fair has testified that a ten-year commercial life span for a garment is indicative that the garment performs a fundamental or basic function--rather than being merely a matter of transitory fashion." App.57a.

The parties' aggregate total sales of the patented garment through 1972 amounted to 821,947 units, and 3,184,617 dollars. App.57a, 66a.

POINT II

NOTHING IN THE FILE WRAPPERS OF THE PATENTS IN SUIT REFLECTS ADVERSELY ON THE VALIDITY OF THOSE PATENTS.

It is difficult to fathom Vanity Fair's file wrapper arguments. P Br. 7-12, 16-19, 26-29. The patent Office Examiner initially rejected Olga's applications, but as noted

by the trial court these rejections were "made on the basis of drawings and written descriptions. After the Patent Examiner had the benefit of actual sample garments and full explanation "these rejections were withdrawn. App.62a.

As for Vanity Fair's attempt to spin an argument from Olga's answer to questions about the effect of turning her garment inside out, P Br. 10-11, it was entirely within the prerogative of the trial court to accept her "profession" of mis-understanding. P Br. 11. And in any case there is no evidentiary basis whatever for Vanity Fair's assertion that an inside-out Olga garment "is precisely the disclosure of the Rosenthal patent." P. Br. 11.

While plaintiff has charged defendant with making various misrepresentations to the Patent Examiner, none of these charges are sustained by the record. Mrs. Erteszek asserted that all the representations made to the Patent Examiner were correct and actually demonstrated to the Court the truth of such assertions using the sample Rosenthal garment, DX A, and the model. App.264a-275a.

The file history, moreover, shows that Rosenthal and the arguments made by Vanity Fair now were thoroughly and fairly reviewed by the Patent Examiner and, after that review, he found the claims here in suit patentable. In Rich Products Corp. v. Mitchell Foods, Inc., 357 F.2d 176 (2 Cir. 1966), cert. denied, 385 U.S. 281 (1966) the Court stated:

"The presumption [of validity] is strengthened, in a case such as this, where the same questions were raised in prosecuting the patent in the Patent Office and there successfully met." 357 F.2d, at 181.

POINT III

THE GARMENT PATENT CASES RELIED ON BY VANITY FAIR ALL INVOLVED VERY DIFFERENT FACTS FROM THOSE HERE PRESENT

In International Latex Corp. v. Warner Bros. Co., 276 F.2d 557, 562 (2 Cir. 1960) this court upheld the validity of the corset patent in suit and reminded that "in this field each case must necessarily depend on its own facts...."

In the patent cases cited by Vanity Fair at P Br. 20-26 the courts summarized the state of the prior art as follows:

"Concededly the Roth prior use, if proved, was a complete anticipation of those claims of the patent in suit which cover a corset having a one-way vertical stretch front panel.... We are satisfied that it [the proof] was sufficient...." Warner Bros. Co. v. American Lady Corset Co., 136 F.2d 93, 95 (2 Cir. 1943).

It is interesting to note that in Warner Bros. Co. V. Treo Co., 33 F. Supp. 741 (E.D.N.Y. 1940), at a time before the Roth prior use was discovered, the patent, which was held invalid in Warner Bros. v. American Lady Corset Co., supra, because of the Roth prior use, was held valid. Going on--

"In the patent...all of the elements are old; all of the results of the aggregation of the elements are predictable...." Modella Manufacturing Co. v. Famous Bathrobe Co., 151

F.Supp. 542, 543 (S.D.N.Y. 1956)

"The District Court found that the features of the claimed invention, which plaintiff insists is an advance over the prior art, is the convergent strips of arrowshaped bands.... The District Court found such bands were well known in the prior art and were specifically disclosed in patents to Levy, No. 2,458,279 and Imershein, Re. 21595. Neither Levy nor Imershein patents were a patent office reference." H. W. Gossard Co. v. J. C. Penny, 304 F. 2d 515, 516 (2 Cir. 1962)

"The prior art references that came under his [the lower Court's] careful scrutiny are the Goldin patent...which discloses a belt whose length is adjustable in exactly the same manner as appellant's cummerbund; and several patents on adjustable necktie construction that disclose, singly or in combination, virtually all of the elements contained in appellant's cummerbund.... When appellant's witnesses were confronted with the details of this prior art, their attempts to show significant differences between these references and appellant's cummerbund merely served to establish the fact that there are no significant differences." Formal Fashions, Inc. v. Braiman Bows, Inc., 362 F.2d 536 (2 Cir. 1966)

Clearly, therefore, these cases afford no basis for overturning the lower court's carefully documented and reasoned decision in the case at bar.

POINT IV

THE 301 PATENT IN SUIT IS NOT PRIOR ART AS TO THE 300 PATENT IN SUIT

The old cases cited by Vanity Fair as authority

for the proposition that the 301 patent is prior art to the 300 patent, P Br. 32-3, all were based upon the early doctrine (long since voided by changes in the patent laws) of Underwood v. Gerber, 149 U.S. 224 (1893), that all unclaimed disclosure in an issued patent is deemed to be irrevocably abandoned to the public unless a "reservation" thereof appears in the patent as issued. According to the practice of filing "continuation-in-part" applications, which has grown up in the meantime and which is now statutorily sanctioned by Section 120 of the 1952 Patent Act, Title 35 U.S.C.A., (See Federico, Commentary on the New Patent Act, Title 35 U.S.C.A., Vol. 1, p.33), the 300 patent is entitled to the filing date of the 301 patent for all subject matter common to both patents. This is the same thing as saying that 301 is not prior art to 300.

It is true, of course, that successive patents to the same patentee can if their claims are sufficiently close, give rise to "double patenting." That situation is not here present, but if it were the fact that the two Olga patents issued on the same day would preclude application of that doctrine. Thercoz Co. v. United States Ind. Chemical Co., Inc., 14 F.2d 629, 640 (D.C. Md. 1926), aff'd 25 F.2d 387 (4th Cir. 1928), cert. den. 278 U.S. 608; J. R. Clark Co. v. Jones & Laughlin Steel Corp., 288 F.2d 279 (7th Cir. 1961),

cert. den. 368 U.S. 828 (1961); Pursche v. Atlas Scraper & Engineering Co., 300 F.2d 467 (9th Cir. 1961), cert. den. 371 U.S. 911 (1962); W. A. Sheaffer Pen Co. v. Eagle Pencil Co., 55 F.2d 420 (S.D.N.Y. 1931).

CONCLUSION

For the reasons hereinabove set forth this appeal should be dismissed and the lower court's judgment affirmed.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

VNAITY FAIR MILLS, INC.,
Plaintiff-Appellant

vs.

OLGA COMPANY INC.
Defendant-Appellee,

**AFFIDAVIT
OF SERVICE**

Appeal from the United States District Court for the Southern
District; to review Decision in a decla

STATE OF NEW YORK,
COUNTY OF New York, ss:

deposes and says that he is over the age of 21 years and resides at 2530 Young ave, Bro
Harold Dudash being duly sworn,
Bronx, N.Y.

That on the 30th day of September 1974 at
he served the annexed Defendant-Appellee's Brief upon

Pennie & Edmonds/ Morton Taylor & Adams, esqs.
in this action, by delivering to and leaving with said Attorneys for Plaintiff-Appellant
three true copies true cop thereof.

DEPONENT FURTHER SAYS, that he knew the person so served as aforesaid to be the
person mentioned and described in the said

Deponent is not a party to the action.

Sworn to before me, this 30th

day of September 1974 }

Roland W. Johnson
ROLAND W. JOHNSON
Notary Public, State of New York
No. 4507795
Qualified in Delaware County
Commission Expires March 30, 1975

Harold Dudash